

REMARKS

The present Amendment is in response to the Examiner's Office Action mailed October 10, 2006. Claims 19-49 are cancelled, claim 1 is amended, and new claims 50-76 are added. Claims 1-18 and 50-75 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

I. PRIOR ART REJECTIONS

A. Rejection Under 35 U.S.C. § 103

The Examiner rejects claims 1-7 and 9-18 under 35 U.S.C. § 103 as being unpatentable over *Liu et al* (U.S. Patent No. 6,762,997) in view of *Heil* (U.S. Patent No. 6,944,152). Applicants traverse the Examiner's rejection for obviousness on the grounds that the references – either individually or in combination – fail to teach or suggest each and every element of the rejected claims.

According to the applicable statute, a claimed invention is unpatentable for obviousness if the differences between it and the prior art “are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a) (2005); *Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966); MPEP 2142. Obviousness is a legal question based on underlying factual determinations including: (1) the scope and content of the prior art, including what that prior art teaches explicitly and inherently; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention

and the prior art; and (4) objective evidence of nonobviousness. *Graham*, 383 U.S. at 17-18; *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999). It is the initial burden of the PTO to demonstrate a *Prima facie* case of obviousness. If the PTO does not set forth a *Prima facie* case of obviousness, the applicant is under no obligation to submit evidence of nonobviousness. MPEP 2142 (emphasis added).

According to MPEP section 2143:

To establish a *Prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added).

Liu relates to a method for finding shortest network routing paths subject to system constraints. *See Title*. *Liu* finds the shortest network routing paths based on five parameters, (“node identifier”, “accumulated length”, “accumulated delay”, “CSP lower bound length”, “smallest delay from a current node”), which can be summarized as path length and node delay. *See* column 4, lines 39-58; col. 3, lines 15-25; column 6, lines 25-34; column 7, lines 35-44; column 8, lines 1-8.

Claim 1, as amended, includes the element, “parameterizing a set of attributes for a desired data path between the process and the storage device of the SAN, wherein the set of attributes includes a detail about at least one data volume; a performance setting; and a policy setting; and constructing the data path that provides said set of attributes....” Thus, claim 1 requires more than just consideration of path length and node delay. Rather, claim 1 requires parameterization of attributes and construction of data paths based on at least the following: (1) a detail about at least one data volume; (2) a performance setting; and (3) a policy setting. Thus, the Applicant respectfully requests that the rejection of claim 1 be withdrawn at least for the reason that neither *Liu* nor *Heil* teach or suggest each and every element of claim 1.

Claims 2-7 depend from claim 1. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir.

1988). Therefore, the Applicant respectfully requests that the rejection of claims 2-7 be withdrawn at least for the same reasons as claim 1.

Claim 9 includes the elements, “presenting said ranked candidate data paths to a user for selection; and selecting a user-selected candidate data path as the data path to be constructed by said constructing step” in combination with each and every other element of claim 9. The Applicant has reviewed each section of both *Liu* and *Heil* cited by the Examiner and cannot find disclosure of these elements as alleged. Figure 4 of *Heil* discloses a monitor 166, keyboard 168, and pointer 178, but the Applicant respectfully disagrees that this is sufficient disclosure for the required “presenting said ranked candidate data paths to a user for selection” act of claim 9. As such, the Applicant respectfully requests that the rejection of claim 9 be withdrawn.

Claims 10-18 depend from claim 9. Therefore, the Applicant respectfully requests that the rejection of claims 10-18 be withdrawn at least for the same reasons as claim 9.

II. NEW CLAIMS

New claims 50-76 have been added. Claims 50-72 depend from claim 1. Therefore, claims 50-72 are believed to be allowable at least for the same reasons as claim 1.

Claim 73 includes the element, “evaluating each said candidate data path against the set of attributes to rank said candidate data paths from a best candidate data path to a least best candidate data path according to the attributes, wherein a destination storage volume of each candidate data path is ranked” in combination with each and every other element of claim 73. The Applicant believes that claim 73 is allowable at least for the reason that none of the art of record teaches or suggests the act of ranking destination storage volumes of candidate storage paths in combination with each and every other element set forth by claim 73. Claims 74 and 75 depend from claim 73. Therefore, claims 74 and 75 are believed to be allowable at least for the same reasons as claim 73.

Claim 76 includes the element, “evaluating each said candidate data path against the set of attributes to rank said candidate data paths from a best candidate data path to a least best candidate data path according to the attributes, wherein a security attribute of a storage volume is included in the ranking” (emphasis added) in combination with each and every other element of

claim 76. The Applicant believes that claim 76 is allowable at least for the reason that none of the art of record teaches or suggests the combination of elements set forth therein.

CONCLUSION

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 10th day of April, 2007.

Respectfully submitted,

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